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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/935,107  | 08/23/2001  | Preston Cutright     | EL-8165             | 9311             |
| 7590  | 07/25/2006  |                      | EXAMINER            |                  |
| Crowell & Moring, LLP<br>Intellectual Property Group<br>P.O. Box 14300<br>Washington, DC 20044-4300 |             |                      |                     | TOOMER, CEPHIA D |
|   |             | ART UNIT             | PAPER NUMBER        | 1714             |

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                              |                  |
|------------------------------|------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.              | Applicant(s)     |
|                              | 09/935,107                   | CUTRIGHT ET AL.  |
|                              | Examiner<br>Cephia D. Toomer | Art Unit<br>1714 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 May 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,9,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,9,10 and 12-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

This Office action is in response to the amendment filed May 2, 2006 in which claims 1, 10 and 12 were amended.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1, 3, 9, 10 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for the language "wherein the compacted composition is not subjected to heat treatment". This new limitation is not disclosed in the specification and it is well settled that distinguishing features need explicit teachings.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 9, 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derrick (US 3,893,847).

Derrick teaches fuel compositions comprising finely ground minerals or coal dust, water-soluble polymers and water (see abstract; col. 1, lines 3-8; col. 3, lines 7-14). The polymers include copolymers of sodium acrylate and acrylamides and functionalized starches (polysaccharides resins) (see col. 1, lines 62-68; col. 2, lines 1-23; Table 2). The coal dust, water and polymer are combined and are compacted (see claims 1-4). Derrick teaches that the particles of his invention are of a size from 20 to 300 microns (see col. 3, lines 20-23). Derrick teaches the limitations of the claims other than the differences that are discussed below.

Derrick fails to teach that the polysaccharide resins have a molecular weight of less than 500,000. However, a *prima facie* case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

With respect to the origin of the coal dust, Derrick's general teaching of coal dust encompasses all coals and to have selected anthracite, in the absence of unexpected results, would have been obvious to the skilled artisan.

Derrick also fails to teach that the fuel composition is prepared by a pug mill. However, it would have been obvious to one of ordinary skill in the art to use such a

device because Derrick teaches that the fuel of his invention is prepared by use of a rotating disc pelletizer and a pug mill is a similar device.

3. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that all of the products of Derrick are indurated by heat whereas the present invention excludes the heating step. Applicant argues that Derrick teaches almost nothing at all about coal and teaches that finely ground minerals such as coal dust must be indurated by heat and do not work when the pellets are not subjected to heat.

At col. 1, lines 44-54, Derrick teaches "we provide agglomerates comprising a finely ground mineral, an effective amount of a high molecular weight substantially straight chain water soluble polymer and water. We also provide a process of manufacturing agglomerates which process comprises mixing a finely ground mineral with an aqueous solution of an effective amount of a high molecular weight substantially straight chain water soluble polymer and treating the resultant mixture to form agglomerates." At col. 2, lines 52-57, Derrick teaches "when agglomerates manufactured using our process as described hereinabove are indurated by heating... the degree of disintegration .. is reduced." Clearly, heat is not a requirement in the process of Derrick.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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